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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,633	07/30/2003	Muneko Tomioka	2003-0918A	9149

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WASHINGTON, DC 20006-1021

EXAMINER
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NGUYEN, TAI V

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/629,633

Applicant(s)

TOMIOKA ET AL.

Examiner

Tai Van Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3-12 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3 and 4 is/are rejected.
- 7) ☒ Claim(s) 5-11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 07/30/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicants' election without traverse the invention of Group I, claims 3-11 filed on 12/02/2004 is acknowledged.
2. Claim 12 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected the invention II, claim 12, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/02/2004.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3--7 rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants Admitted Prior art (AAPA) in view of Miyashita et al (US 5,325,573).

As applied to claim 3, The AAPA (Prior Art Fig. 8) teaches a surface acoustic wave element manufacturing method, comprising: forming a plurality of surface acoustic wave elements (Fig. 8), each of the surface acoustic wave elements including a plurality of inter-digital transducer electrodes (31, 32) on a piezoelectric substrate, a grating reflector electrode (41, 42) arranged on each side of the plurality of inter-digital transducer electrodes, and a plurality of pad (5) electrodes led from the inter-digital transducer electrodes and led from the grating reflector electrodes (66), forming dicing

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lines (2) on an outer periphery of each surface acoustic wave element so that the plurality of pad electrodes (31, 33) of each surface acoustic wave element includes a plurality of isolated pad electrodes such as read (62) electrically isolated from the dicing lines, and includes a plurality of adjacent pad electrodes such as read (67) directly adjacent to at least one of the dicing lines; forming connecting electrodes for electrically connecting the isolated electrodes (62) to a corresponding one of the adjacent pad electrodes (67); forming short-circuit electrodes for electrically connecting the adjacent pad electrodes to at least one of the dicing lines; forming pad reinforcing electrodes such as read (66) on the pad electrodes.

However, The AAPA does not teach removing at least a portion of each connecting electrode to electrically disconnect each isolated pad electrode from the corresponding one of the adjacent pad electrodes, and cutting the piezoelectric substrate along the dicing lines.

Miyashita et al teach removing at least a portion of each connecting electrode to electrically disconnect each isolated pad electrode from the corresponding one of the adjacent pad electrodes, and cutting the piezoelectric substrate along the dicing lines (see column 6, lines 52-65+). It would have been to one of ordinary skill in the art at this time the invention was made to modify the method of AAPA by utilizing the desired connective electrode and cut as taught by Miyashita et al, to positively eliminate by neutralize the electric potential induced in various conductor part of the device (see column 3, lines 25-27).

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As applied to claim 4, The AAPA further teach forming bumps on the pad reinforcing electrodes (21).

***Allowable Subject Matter***

5. Claims 5-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tai Van Nguyen whose telephone number is 571-272-4567. The examiner can normally be reached on M-F (7:30 A.M - 4:30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TN  
January 5, 2005



A. DEXTER TUGBANG  
PRIMARY EXAMINER